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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 11770US02  
11770US03

OFFICE OF PETITIONS



In Reexamination

MERGED PROCEEDINGS

Examiners: R. Stright and J. Yasko Jr.

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3763

Group Art Units: 3734 and 3763

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, BOX REEXAM and BOX REISSUE, Washington, D.C. 20231 on December 14, 2000.

By:

  
George Wheeler  
Reg. No. 28,766

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01 FC:122 130.00 CH REQUEST FOR RECONSIDERATION OF THE PTO's  
DECISION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

Commissioner for Patents  
BOX REEXAM and BOX REISSUE  
Washington, D.C. 20231

Sir:

The patentee respectfully requests reconsideration of the decision mailed November 15, 2000, merging the reissue and reexamination proceedings referenced in the captions above and requiring the patentee to revise the claims of the reexamination proceeding to be identical to those involved in the reissue proceeding. The decision is contrary to 35 U.S.C. § 305 (and would thus make some of the claims invalid if the

merged reexamination is carried out as ordered), inefficient, and unfair to the patentee under the circumstances of the present case. The patentee has a proposal, presented in Part IV below, that will solve the present problem without the problems attending the ordered merger.

### I. The Ordered Merger Violates 35 U.S.C. § 305

The present reissue proceeding is a broadened reissue application: some of the pending claims are broader than those of the original patent. The reissue application was filed on August 28, 1998, less than two years after the original patent issue date: September 10, 1996. The inventors declared in the reissue application declaration filed on January 6, 1999, that: "I understand that at least claims 18 and 53 are broader than any claim in the original patent."

The present (second) reexamination involves only the original patent claims (1-6). Conforming the claims of the reexamination to match claims 18, 53, and possibly others in the reissue proceeding will therefore broaden some of the proposed claims under reexamination, compared to the claims of the original patent.

35 U.S.C. § 305 states: "No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter." This statute clearly prevents the patentee from complying with the PTO's order to conform the claims of the reexamination to those of the reissue application. If the claims are broadened in reexamination, the resulting broadened reexamined claims will be invalid. *Thermalloy, Inc. v. Aavid Engineering, Inc.*, 121 F.3d 691, 43 USPQ2d 1846 (Fed. Cir. 1997). The loss of valuable patent rights and violation of the statute resulting from the present merger cannot be counterbalanced by any administrative convenience resulting from the ordered merger.

### II. The Ordered Merger is Inefficient and Not Needed to Promote Uniformity

The decision to merge the second reexamination and reissue applications states, as the three considerations bearing on whether applications should be merged:

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. [A] The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. [B] Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. [C] In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding.

Merger decision, p.3 (bracketed lettering added). In the present case, these three considerations all indicate that the second reexamination and the reissue should not be merged.

#### A. The Merger Does Not Promote Uniformity

As quoted above, "The reason for this [merger] policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner." No such amendments have been or will be introduced in the present two proceedings, if they are not merged.

The original patent issued with claims 1-6. The second request for reexamination was filed before the certificate for the first reexamination was issued, so the Director only ordered a second reexamination of original claims 1-6. These are thus the only claims that could conflict in the respective second reexamination and reissue application. Claims 1-6 are identical in the reissue application, the second reexamination, the first reexamination, and the original patent. Claims 1-6 (and also claims 7-56) of the reissue application were allowed and the issue fee was paid nearly eight months ago. The patentee presently has no intention of reopening prosecution of the reissue application, particularly to change original claims 1-6 that are also subject to the second reexamination.

#### B. The Merger has Slowed Down the Reissue Application

The merger order stated, "normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings" (emphasis added). The merger cannot expedite the prosecution of the reissue

application because that prosecution is already complete. It will not expedite the prosecution of the reexamination, either.

The reissue application was filed on August 28, 1998. Prosecution of claims 1-56 in the reissue proceeding was complete on April 6, 2000, when Examiner Yasko closed prosecution and sent out a Notice of Allowability and Notice of Allowance. The patentee paid the issue fee on April 18, 2000. Had the application progressed at a normal rate through the PTO, the patent should have been reissued within four months after the issue fee was paid – by August 18, 2000 – or certainly within six months after the Notice of Allowance issued – by October 6, 2000.

The decision to merge the reissue and reexamination threw the reissue application off course, preventing it from issuing, as the Notice of Allowance was withdrawn and prosecution was reopened. So the merger did not expedite the reissue application. It slowed the reissue application down.

Moreover, this slowdown is not necessary to address the prior art raised in the second reexamination request (which was filed by a third party). All this prior art was cited and filed in the reissue proceeding on February 16, 1999, and considered by the Examiner later in 1999. See Paper No. 7, forms PTO-1449, with all the prior art citations initialed by the Examiner to indicate his consideration. In fact, all but three of the references cited in the second reexamination were already considered in original prosecution or the first reexamination.

In short, there is nothing left to do in the reissue application, other than printing the reissued patent. The present merger is slowing down that process, not expediting it.

The merger will not speed up consideration of the second reexamination, either, since the second reexamination will run its course at the same rate whether it is merged or not.

### **C. The Relative Status of the Reissue and the Reexamination Makes Merger Inappropriate**

The third factor respecting whether cases should be merged is quoted above: "In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding." The patentee respectfully submits that due

consideration of the status of the second reexamination, which is just beginning, and the reissue application, which is complete and should have issued by now, requires that the two cases not be merged.

In 1998, it might have made sense to merge the second reexamination, which was ordered to proceed in June of 1998, and the reissue application, which was filed in August of 1998. By August, 1998, the first reexamination certificate had issued, and no Office action had issued in either pending proceeding. The second reexamination and reissue were assigned to different examiners, and it would have made sense to merge them and assign them to the same Examiner in 1998. But that is not what happened.

What happened is that the PTO lost the reexamination file sometime after June of 1998, and never acted again on the second reexamination during the next 2 ½ years.

After repeated status inquiries in writing and by telephone, the patentee finally was told that the file needed to be reconstructed, which the patentee facilitated by providing its copies of the missing papers. Meanwhile, the reissue application was prosecuted normally and allowed and the issue fee was paid during the same period.

As a result, the relative status of the second reexamination and the reissue application is very different today. The opportunity to save time, effort, and money was lost along with the second reexamination file.

### **III. The Ordered Merger is Unfair to the Patentee**

The broadened claims in the reissue application are subject to intervening rights, to the extent that they are not substantially identical to the original patent claims. See 35 U.S.C. § 252. The patentee thus does not have enforceable rights in the broadened claims until they are issued. The grant of the present reissued patent has been delayed already, and is being further delayed by merging it with a reexamination that will require perhaps a year to be completed (with further delays if an appeal should prove necessary or if yet another third-party reexamination request is filed). The reissued patent will expire on the same day as the original patent would have expired. In short, every day of delay in issuing the reissued patent is a day of broader rights lost by the patentee.

This situation did not result from any action or inaction on the part of the patentee. This situation resulted because the PTO lost the second reexamination file for an extended period. The patentee inquired about its status many times, both before and after the papers required for reconstruction were provided. Specifically, inquiries were made by telephone (except where indicated to be "written") on at least the following days:

10/07/98	
11/11/98	
02/26/99	
06/14/99	
09/01/99	Written
11/01/99	Written
12/02/99	Written
03/02/00	
05/26/00	
06/01/00	
06/08/00	
06/12/00	
06/20/00	
06/27/00	
08/01/00	
08/31/00	
09/25/00	
11/08/00	
11/09/00	

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The written status requests were never answered.

The patent owner should not be burdened and have its rights unreasonably delayed by merging the reexamination and reissue proceedings, in view of this history.

#### **IV. A Proposed Alternative Procedure**

The patentee suggests an efficient way to proceed at this point. Unmerge the two proceedings, reissue the patent with claims 1-56 promptly, then reexamine claims 1-6 of the reissued patent, as ordered. Since only the second reexamination will be pending after the patent is reissued, conflicting amendments in the two proceedings will not be a problem. The Director can attach the certificate for the second reexamination to the reissued patent. That way, the reexamination requester will get the

reexamination it paid for, while the patentee will get the reissued patent it paid for and is entitled to.

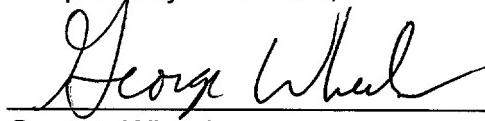
There is no need to merge the two proceedings, since all the claims they have in common are identical. By reissuing the patent promptly, the problems of two copending actions relating to the same patent will be solved. There is no need to stay the second reexamination, since the time to prepare and mail a first Office action in the second reexamination, added to the allotted time for the patentee to respond, is long enough to allow the patent to be reissued. Just as the two reexamination proceedings were pending concurrently without incident for the short time needed to print the first reexamination certificate, the reexamination and reissue proceedings can be pending concurrently for the short time needed to print the reissued patent.

Therefore, the patentee respectfully requests that the merger order be withdrawn, the patent be reissued with claims 1-56, and the reexamination proceed without further delay, taking into account the fact that the prior art in the reexamination was already considered and overcome during the broadening reissue proceeding, respecting all of claims 1-56.

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Respectfully submitted,

  
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